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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,532	07/29/2003	D. Y. Yang	22171-00005-US	1531

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EXAMINER

SOBUTKA, PHILIP

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,532

Applicant(s)

YANG ET AL.

Examiner

Philip J. Sobutka

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 1-11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The following title is suggested: "Portable Network Transmission Device with SIM for Computer".

Drawings

3. The drawings are objected to because in all of the figures, the quality of the lines is poor and most likely will not reproduce well for printing.

Per 37 CFR 1.84 (I) :

Character of lines, numbers, and letters: All drawings must be made by a process which will give them satisfactory reproduction characteristics. Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined. The weight of all lines and letters must be heavy enough to permit adequate reproduction.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

Art Unit: 2684

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 1-11 are objected to because of the following informalities: the claims should be labeled "Claim 1", "Claim 2", "Claim 3", etc, not "[C1]", "[C2]", "[C3]", etc. Appropriate correction is required.

Claim 1 is objected to because of the following informalities: in the claim element that recites: *whereby the subscriber identification module is used to provide network... functions for a user with a simple configuration*: the term "*with a simple configuration*" should be deleted. It appears to be merely superfluous description of the benefits of the conventional SIM card, rather than a limitation of the instant invention. Note that if it were intended to somehow be construed as a limitation, "simple" is a relative term which would render the claim indefinite, since "simple" is not defined by the claim, and the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1,2,4,5,6,8-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rauhala et al (US 6,327,153) in view of Galecki (US 5,444,764).

Claim 1. Rauhala teaches a portable network transmission device, comprising:
a computer terminal (*While Rauhala's figures do not show the computer, the disclosure describes how the wireless communication device is arranged as a standard expansion card for connection to a personal computer by insertion on column 1, lines 8-59, and column 3, lines 38-42*):

Art Unit: 2684

a case (*Rauhala's expansion card housing, see especially figures 1, 5*), one end of the case connected to the computer terminal (*Rauhala in column 3, lines 38-42, and column 1, lines 34-47, describes how the pc expansion card is equipped with a connector which connects the card with a PC*);

and a subscriber identification module configured within the case (*Rauhala, on column 7, lines 11,12 describes how the expansion card is provided with an opening for insertion of the subscriber identity module or SIM of the card phone*).

Rauhala lacks a teaching of the subscriber identification module being used to provide network roaming or billing functions for a user with a simple configuration. *Note that the claim language only requires roaming or billing, but not both.* Galecki teaches that SIM cards are used to provide roaming and billing capabilities (*Galecki in column 1, lines 15-22 describes how in radiotelephone systems, such as GSM, a SIM card is inserted into a radiotelephone for providing subscriber identification and billing information, allowing the same hardware to be used with any SIM card inserted*), thus allowing the user to easily change them out the subscriber identity in wireless devices. Note that this easy change out corresponds to the claimed "simple configuration". It would have been obvious to one of ordinary skill in the art to modify the SIM card of Rauhala to provide billing functions in order to allow the user to easily pay for use of the wireless network through the billing function provided by the SIM card as taught by Galecki.

As to claim 2, note that Rauhala's case has an opening for inserting the subscriber identification module (*Rauhala, on column 7, lines 11,12 describes how the*

expansion card is provided with an opening for insertion of the subscriber identity module of the card phone).

As to claim 4, note that Rauhala's opening is on one side of the case (*Rauhala, on column 7, lines 11,12 describes how the expansion card is provided with an opening for insertion of the subscriber identity module of the card phone).*

As to claim 5, note that a text search of the pre grant publication of the instant application yielded no further description of the term "embedded". The word is only used in claim 5. Since the instant figures and disclosure relate a SIM card that is inserted into the PC card case, this claim has been taken to mean that the SIM is inserted into the case, rather than being plugged into an exposed socket. (*Rauhala teaches the SIM card being inserted into a side opening on column 7, lines 11,12, therefore, when Rauhala's SIM is inserted into the side opening, it is embedded, that is to say, inserted within the card case).*

As to claim 6, note that Rauhala teaches a wireless transmission portion is placed on one side of the case opposite to the computer terminal (*Rauhala as shown in figure 5, and described in column 1, lines 44-48, notes that the end of the card opposite the connector is often located outside of the computer for placement of the antenna of the wireless device, note that this antenna would correspond to the claimed wireless transmission device).*

As to claim 8, note that Rauhala's device is a PCMCIA card (*Rauhala notes in several places that the card conforms to the PCMCIA standard, notably, column 1, lines*

Art Unit: 2684

34-59, column 3, lines 30-35, and column 7, lines 3-5). Note that the claim requires only one of the claimed alternatives, not all.

As to claim 9, note that Rauhala's computer terminal has a PCMCIA port, *(Rauhala, in addition to describing the card conforming to the PCMCIA standard, notes that the insertion slot on the Personal Computer would conform the to PCMCIA standard as well, see column 1, lines 34-39, column 3, lines 30-35). Note that the claim requires only one of the claimed alternatives, not all.*

As to claim 10, note that Rauhala's wireless device is a wireless LAN module *(Rauhala, in column 1, lines 19-33, describes how Personal Computers can, by means of the card like wireless module, be in connection with data networks such as LAN's).*

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rauhala et al (US 6,327,153) in view of Galecki (US 5,444,764) as applied to claim 2 above and in view of Learmonth et al (US 6,075,706).

Consider claim 3. Rauhala in view of Galecki teach the device of claim 2 as shown above, but lack a teaching of the opening being a shutter window placed on the top of the case. *Note that the term shutter window is shown in the instant specification in figure 4, item 42, to mean an opening with a shutter that is a covered window.*

Learmonth teaches a PC card with an opening for a smaller card, such as a SIM wherein the opening is a covered, or shuttered, opening on the top of the case.

(Learmonth teaches a PC card constructed in accordance with PCMCIA standards, with an opening for a smaller "chip card" such as a SIM card used to authorize mobile telephone use, as shown in Column 1, lines 4-25. Learmonth teaches the opening

Art Unit: 2684

being on the top of the card in figures 1,3,10, with a shutter or lid shown as item 26 in figures 1, and 3, and item 326 in figure 10, and described on column 3, lines 48-64, and column 5, lines 3-40). It would have been obvious to one of ordinary skill in the art to further modify Rauhala to provide the SIM card opening on the top of the card as shown in Learmonth in order to provide easy access for insertion and removal by exposing the whole card rather than merely the side, as well as providing a shutter or lid to prevent damage or accidental dislodge of the SIM card.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rauhala et al (US 6,327,153) in view of Galecki (US 5,444,764) as applied to claim 1 above and in view of Mays (US 5,361,061)

Consider claim 7. Rauhala in view of Galecki teach the device of claim 1 as shown above, but lack a teaching of a non-volatile memory in the case. Mays teaches a wireless network computer card with non-volatile memory (ROM) in the card case (*Mays teaches a PCMCIA computer card, as described on column 1, lines 12-25 configured as a wireless communication device as shown in figures 1 and 4, and described in column 2, lines 45-65, and column 4, lines 3-20. Mays teaches the wireless communication device utilizing ROM memory. As is well known in the art, ROM, i.e. read only memory, is non-volatile memory, meaning it is memory that does not lose stored data when the power is removed*). It would have been obvious to one of ordinary skill in the art to modify Rauhala to provide a non-volatile memory such as a ROM in order to ensure that stored data was not lost when the device was powered down.

Art Unit: 2684

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rauhala et al (US 6,327,153) as applied to claim 1 above and further in view of Galecki (US 5,444,764) and in view of Joyce et al (US 2003/0026404)

Consider claim 7. Rauhala in view of Galecki teaches the device of claim 1, but lack a teaching of the SIM pre-paying Internet access. Joyce teaches using a SIM to pre-pay Internet access. (*Joyce, in paragraph 29 teaches that pre-paid amounts can be programmed onto a SIM card to procure services, the services including Internet service as shown in paragraph 191*). Therefore it would have been obvious to one of ordinary skill in the art to modify Rauhala to provide the SIM with the capability of pre-paying Internet service, in order to allow the user to access internet service without regard to payment at the time of access.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Sobutka whose telephone number is 571-272-7887. The examiner can normally be reached Monday through Friday from 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882.

13. The central fax phone number for the Office is 571-273-8300.

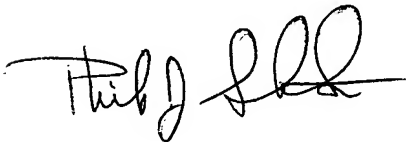
Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must

Art Unit: 2684

be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



11/28/2005

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